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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,113	02/25/2002	Paul Trpkovski	44046.103.130.21.2	6810

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EXAMINER
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CULBERT, ROBERTS P

ART UNIT	PAPER NUMBER
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1763

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/084,113	<b>Applicant(s)</b> TRPKOVSKI, PAUL	
	<b>Examiner</b> Roberts Culbert	<b>Art Unit</b> 1763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/11/02 &amp; 1/13/03</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-4 and 29-33, drawn to an apparatus, classified in class 219, subclass 121.78.
- II. Claims 5-28, drawn to a method, classified in class 216, subclass 65.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as a laser mounted on a robot arm.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Allen W. Groenke on 12/1/03 a provisional election was made with traverse to prosecute the invention of Group II, claims 5-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-4 and 29-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 5-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,904,867 to Herke.

Herke teaches a method of etching in providing a laser beam etcher (85) capable of etching an image in a planar work piece, positioning a work piece perpendicularly to the aim of the etcher (figure 1), calculating an optimal location for the indicia according to established parameters, moving the laser beam etcher adjacent to the optimal location, determining an optimal orientation for the image, deriving orientation data from the optimal location and transmitting the image data and orientation data to the laser beam etcher and instructing the laser beam etcher to fire (figure 2).

Herke also teaches obtaining the dimensions of the surface, inputting an approximate desired indica location and a desired location, calculating an optimal indica location on the surface according to the desired location, effecting the movement of an indica-imparting device to the optimal indica location on the surface relative, and imparting the indica at the optimal indica location on the planar surface.

Herke also teaches that the step of emitting light from the laser in a pattern is effected according to a computerized image file, and that the orientation data is incorporated into the image data prior to transmission to the laser beam etcher. See (Col. 7, Lines 55-65)

Herke also teaches the subject of the work piece having a first edge and a second edge (figure 1), determining a location for the desired indicia at an intersection of a first and second inset line (186), the first and second inset lines being at an angle to each other, and a specified distance form a first and second tangent line, where the first and second tangent line are tangent to a first and second edge of the work piece, determining a first and second offset distance from a first and second edge of the work piece, positioning the etcher at a point along the first dimension, at a distance from the first edge equal to the first offset distance, and positioning the etcher at a point along the second dimension at a distance from the second edge equal to the second offset distance (Col. 7, Lines 7-54).

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Herke does not teach that the work piece is planar, however it is clear that the device of Herke would be effective to etch a planar or curved surface since the device maintains a constant distance between the laser and the work piece. It would have been obvious to one of ordinary skill in the art at the time of invention to use the device of Herke on a planar work piece in order to suitably provide indicia on the surface.

Herke does not explicitly teach that the orientation data and image data are transmitted to the laser etcher as separate data elements. However, since Herke teaches that a computer program such as "Corel Draw" is used to form the image file, and such drawing programs are known in the art to inherently provide orientation data and image data for image files, it would have been obvious to one of ordinary skill in the art at the time of invention to transmit the orientation data and image data to the laser as separate data elements, in order to provide an image that may be placed on a surface in the desired orientation.

Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,904,867 to Herke in view of the admitted prior art.

Regarding Claims 24-28, Herke teaches that the device is used to engrave graphical images. It would have been obvious to one of ordinary skill in the art at the time of invention to provide text, logo, specification information etc. as the application requires as these are all types of graphical images that may be formed with engraving as is known in the art.

However, the admitted prior art in the background of the instant application also teaches that it is known in the art to etch indicia such as logo information, text information (perimeter writing), window specification information, and NFRC ratings into a planar glass surface. Applicant further admits that it is known to use a laser to etch indicia into a planar glass surface.

The admitted prior art further teaches that it is known to test a work piece to determine window specification data.

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It would have been obvious to one of ordinary skill in the art at the time of invention to use the etching mechanism of Herke to etch indicia such as logo information, text information (perimeter writing), window specification information, and NFRC ratings into a planar glass surface as shown by the admitted prior art in order to suitably form the desired markings using a laser.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberts Culbert whose telephone number is (571) 272-1433. The examiner can normally be reached on Monday-Friday (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on (571) 272-1439. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R. Culbert



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